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09/068,238	03/26/1999	Udo Nobel	766X89029IN	2114

7590

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/068,238

Applicant(s)

NOBEL ET AL.

Examiner

Patricia L. Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-52 is/are pending in the application.
- 4a) Of the above claim(s) 44-52 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 28-39 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Applicant's election with traverse of Group I in the reply filed on May 9, 2005 is acknowledged. The traversal is on the ground(s) that Group III should be included with Group I because there is a special technical feature between the two groups. This is not found persuasive because of the rejection of the claims of Group I which will follow, which is evidence that there is not a special technical feature in claim 1 and therefore no link to Group III.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 44-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 9, 2005.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "inward-facing side" in claim 39 is a relative term which renders the claim indefinite. The term "inward-facing side" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is the inward-facing side? How is it inward-facing? What is it inward facing in relation to?

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 28-32, 38, 40 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Braendle et al. (US Patent 4,986,867).

Regarding claims 28 and 43, Braendle et al. discloses a window for a vehicle, comprising: a glazing (1); an elastomeric glazing profile (7) disposed around at least a part of the periphery of said glazing on a margin of a face of said glazing (Fig. 6); a mounting flange (10) having an inner edge defining an aperture in a vehicle body, a first face facing said glazing profile and a second face (15 in Fig. 6) facing away from said glazing, wherein said glazing is inserted in said aperture from outside the vehicle body (since portion 2 of the glazing faces the interior of the vehicle and the glazing with the profile is prefabricated to be mounted on the vehicle, it would have been inherent that the window is inserted from outside the vehicle body); wherein said profile (7) has a raised portion (9) that is shaped and positioned to center said glazing (1) within said aperture during insertion of said glazing in said aperture by bearing against said inner edge of said mounting flange; wherein said raised portion (9) comprises a tip (14) positioned so that after insertion of said glazing, said tip bears against said second face of said mounting flange facing away from said glazing (Fig. 6); and wherein said glazing is bonded to said mounting flange by an adhesive material (11).

Regarding claim 29, Braendle et al. discloses the window of claim 28, wherein said raised portion (9) of said profile (7) is in the form of a lip (14) extending away from said glazing which, after insertion of said glazing in said aperture, extends beyond said inner edge of said mounting flange (10) and over said second face of said mounting flange facing away from said glazing.

Regarding claims 30 and 31, Braendle et al. discloses the window of claim 29, wherein said profile (7) further includes a spacer portion (8) on a peripheral side of said raised portion (9), said spacer portion (8) abutting said first face of said mounting flange during installation and acting as a stop for said glazing and maintaining said glazing in a fixed spaced relationship to said mounting flange.

Regarding claim 32, Braendle et al. discloses the window of claim 28, wherein said raised portion (9) is adapted to retain said glazing in a centered position with respect to the mounting flange (10) while said adhesive material (11) sets during installation (column 6, lines 8-15).

Regarding claim 38, Braendle et al. disclose the window of claim 28, wherein said raised portion of said profile comprises a first surface (9) at a first slanting angle relative to said mounting flange which initially centers said glazing as said glazing is initially moved to said aperture, and a second surface (8) at a second slanting angle to the mounting flange that maintains a centered position of said glazing after insertion of said glazing into said aperture and a step between said first surface and said second surface engaged by said inner edge of said mounting flange.

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Regarding claim 40, Braendle et al. disclose the window of claim 28, wherein said glazing profile comprises a single piece of elastomeric material.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braendle et al. in view of Schroter (EP 0304694).

Braendle et al. disclose the window of claim 28.

Braendle et al. do not disclose a lip on a peripheral side thereof having a base extending outwards from said glazing and a body extending in a curved towards a direction perpendicular to said face of said glazing, said lip sealing against said mounting flange.

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Schroter discloses a profile with a lip (10) on a peripheral side thereof having a base extending outwards from said glazing and a body extending in a curved towards a direction perpendicular to said face of said glazing, said lip sealing against said mounting flange.

Braendle et al. and Schroter are analogous art because they are from the same field of endeavor, i.e., window glazing profiles for centering the glazing on a vehicle aperture.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include an additional lip sealing against the mounting flange.

The motivation would have been to provide additional protection against the adhesive becoming exposed to the environmental conditions which could degrade its performance, such as rain.

Therefore, it would have been obvious to combine Schroter with Braendle et al. to obtain the invention as specified in claim 33.

11. Claims 34-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braendle et al. in view of Ohlenforst et al. (US Patent 5,261,718).

Braendle et al. disclose the window of claim 28.

Braendle et al. do not disclose that the raised portion is in the form of a curled lip.

Ohlenforst et al. discloses a profile with a raised portion is in the form of a curled lip (40), further comprising means for pulling said lip over the mounting flange (38).

Braendle et al. and Schroter are analogous art because they are from the same field of endeavor, i.e., window glazing profiles for centering the glazing on a vehicle aperture.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to include make the raised portion in the form of a curled lip and to use a pulling means for pulling the lip over the flange as taught by Ohlenforst et al.

The motivation would have been to make allow the raised portion to have a large lip and to allow it to be installed easily.

Therefore, it would have been obvious to combine Ohlenforst et al. with Braendle et al. to obtain the invention as specified in claims 34 and 35.

Regarding claims 36 and 37, the Examiner takes Official notice that using a metal wire of a cord as the pulling means is well known in the art and would have been obvious to one of ordinary skill in the art at the time of the invention to use a metal wire or a cord. The motivation would have been to use an inexpensive means for pulling the lip over the mounting flange.

Regarding claim 39, Braendle et al. discloses the window of claim 38. Braendle et al. do not disclose a groove along the profile. Ohlenforst et al. disclose a profile with two different height raised portions (18 and 21) with a groove (17) along the profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a groove along the profile. The motivation would have been to ensure proper alignment of the glazing and the mounting flange.

***Allowable Subject Matter***

12. Claims 41 and 42 are allowed.



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*Response to Arguments*

13. Applicant's arguments with respect to claims 28-43 have been considered but are moot in view of the new ground(s) of rejection.

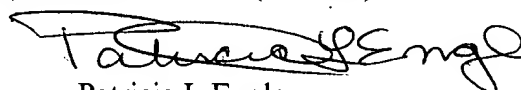
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Engle whose telephone number is (571) 272-6660.

The examiner can normally be reached on Monday - Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle  
Primary Examiner  
Art Unit 3612

ple  
June 23, 2005